

### **REMARKS/ARGUMENTS**

With this Amendment, Applicant amends claims 33, 42, 48, 50, 125, 126, 127, 128, 129, 130 and adds new claims 134-137. No new matter is added. Therefore, claims 1-45, 48-56 and 60-133 are currently pending in the application. However, claims 1-32 and 59-124 are withdrawn from consideration. Based on the foregoing amendments and the following remarks, Applicant respectfully requests reconsideration of the application and allowance of the claims.

#### **I. Objections to Claims 48 & 50**

Claims 48 and 50 are objected to “because they depend on a claim (specifically, claim 46) which has been canceled.” (See pg. 2 of the Office Action) Applicant herein amends claims 48 and 50 such that these claims depend from independent claim 33. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the objections to claims 48 and 50.

#### **II. Rejection of Claims 33, 42 & 125 Under 35 U.S.C. § 112, Second Paragraph**

Claims 33, 42 and 125 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. (See pgs. 2-3 of the Office Action) Applicant herein amends claims 33, 42 and 125 and submits that these self-explanatory claim amendments overcome the rejection. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 112, second paragraph rejection of claims 33, 42 and 125.

#### **III. Rejection of Claims 33-40, 42-45 & 48-56 Under 35 U.S.C. § 103(a)**

Claims 33-40, 42-45 and 48-56 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Westbury et al. (U.S. Patent No. 6,873,963; hereinafter “Westbury”) in view of Swan et al. (U.S. Patent No. 6,901,304; hereinafter “Swan”) in further view of Boucher et al. (U.S. Patent Appln. Publn. No. 2003/0097306; hereinafter “Boucher”).

Claim 33 recites “[a] system ... comprising:” *inter alia* a sender computer system ... configured to: transmit object identification data identifying an object, the object defined by a

sender to identify either a product, a package containing the product, or a group of packages containing products; and a carrier computer system comprising: a processor configured to: receive the object identification data; receive package identification data; receive event data that is generated as the object passes through at least one portal having at least one scanner; *store the object identification data in association with the package identification tag the object identification data, the package identification data, and the corresponding event data such that the tagged data can be read and used by computer systems implementing various data formats, protocols, and applications data and the event data in association with the package identification data*; and transmit the tagged data to a third computer system.”

Applicant submits that the combination of Westbury, Swan and Boucher do not teach or suggest all of the above features of claim 33. In contrast to claim 33, Westbury, at best, discloses a method for tracking material being transferred from a source or supplier to a destination by a carrier. (Col. 1, lines 7-10 & Abstract of Westbury) In this regard, Westbury describes that carrier information is associated with the supplier information to obtain an accurate estimate of when supplier goods are to reach a manufacturer. (Col. 2, lines 26-28 of Westbury). In rejecting claim 33 and asserting that the combination of Westbury, Swan and Boucher discloses “stor[ing] the object identification data in association with the package identification data and the event data in association with the package identification data,” as required by claim 33, the Examiner relies on “column 5, lines 13-16” of Westbury. (See pg. 5 of the office Action) In contrast to the Examiner’s assertion, the cited portion and indeed all of Westbury, at best, discloses that a “tracking system 20 loads ... information provided by all commodity information and all the carrier shipment notifications into a standard database.” (Col. 5, lines 13-16 of Westbury) In rejecting claim 33, Applicant notes that the Examiner relies on a “part number” as corresponding to the claimed object identification data and a “unique package number” as corresponding to the claimed package identification data. (See pg. 5 of the Office Action) Additionally, the Examiner relied on an “‘electronic document’ ... referred to as a carrier shipment notification form” that is issued by carrier 14 as corresponding to the claimed event data. (See *id.* & Col. 4, lines 25-28 of Westbury)

Notwithstanding the Examiner's assertion, nowhere in column 5, lines 13-16 or any other portion of Westbury is there any mention, teaching or suggestion relating to storing the part number (alleged object identification data) in association with the unique package number (alleged package identification data) and storing the electronic document i.e., the carrier shipment notification form (alleged event data) in association with the unique package number (alleged package identification data) as required by claim 33. In contrast to claim 33, "load[ing] information provided by all commodity information and all the carrier shipment notifications into a ... database" as, at best, described in column 5, lines 13-16 of Westbury (relied upon by the Examiner) does not teach or suggest storing a part number (alleged object data) in association with a unique package number (alleged package identification data) and storing a carrier shipment notification form (alleged event data) in association with a unique package number (alleged package identification data), as required by claim 33. Rather, Westbury, at best, discloses that the commodity information and the carrier shipment notification are combined to "obtain one source" that is stored in a database. (Col. 5, lines 6-16 of Westbury) However, storing combined commodity information and a carrier shipment notification form in one source does not teach or suggest storing a part number in association with a unique package number and storing a carrier shipment notification form in association with a unique package number, as required by claim 33. The interrelationship of claim elements is simply not met by Westbury, alone or in combination with Swan and Boucher. For at least this reason, Applicant submits that the combination of Westbury, Swan and Boucher do not teach or suggest all of the features of claim 33.

The Examiner correctly concedes that Westbury does not teach or suggest all of the features of claim 33. For instance, the Examiner correctly concedes that Westbury "does not specifically show tagging the object identification data, the package identification data, and the corresponding event data." (See pg. 6 of the Office Action) However, the Examiner relies on Swan and Boucher to make up for the deficiencies of Boucher. (See *id.*) Applicant respectfully disagrees and submits that neither Swan nor Boucher, alone or in combination, makes up for the deficiencies of Westbury. In particular, the Examiner relies on Swan as disclosing "at least one portal has at least one scanner" and relies on Boucher as disclosing "tagging data". (See *id.*)

In asserting that the combination of Westbury, Swan and Boucher discloses “tag[ging] the object identification data, the package identification data, and the corresponding event data such that the tagged data can be read and used by computer systems implementing various data formats, protocols, and applications,” as required by claim 33, the Examiner relies on paragraph [0035] of Boucher. (See pages 6 & 7 of the Office Action) In contrast to the Examiner’s general assertion, the cited portion and indeed all of Boucher, at best, discloses an XML format defined to “include specific data tags.” (Paragraph [0035] of Boucher) In this regard, Boucher explains that a client browser 23 creates a XML instance document that may “list ... two carriers (Federal Express and United Parcel Service) and services” and discloses a table, namely Table 1, that utilizes XML and specific data tags that may be used by a shipping server 22 in association with identified shipping carriers. (See *id.*) However, nowhere in the cited portion or any other portion of Boucher is there any mention, teaching or suggestion relating to tagging object identification data, package identification data and event data. Additionally, nowhere in the cited portion or any other portion of Boucher is there any motivation for tagging object identification data, package identification data and event data either. Rather, Boucher, at best, discloses tagging all services that are offered by a carrier, such as an overnight service. (Paragraph [0036] & Table 1 of Boucher) Nowhere in Boucher is there any mention, teaching or suggestion relating to tagging data so that it can be “read and used by computer systems implementing various data formats, protocols and applications,” as required by claim 33, either. For at least these additional reasons, Applicant submits that the combination of Westbury, Swan and Boucher is improper as lacking motivation to combine the citations, and further does not teach or suggest all of the features of claim 33.

Based on at least the foregoing reasons, Applicant submits that the combination of Westbury, Swan and Boucher is deficient and does not teach or suggest all of the features of claim 33 and its dependent claims 34-45 and 48-56.

#### **IV. Rejection of Claim 41 Under 35 U.S.C. § 103(a)**

Claim 41 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Westbury in view of Swan in further view of DeVries et al. (U.S. Patent Appln. Publn. No.

2003/0009396; hereinafter “DeVries”) Applicant traverses this rejection for at least the following reasons.

As discussed above, the combination of Westbury and Swan is deficient vis-à-vis independent claim 33 and DeVries does not make up for the deficiencies of Westbury and Swan. Accordingly, Applicant submits that claim 41 is patentable at least by virtue of its dependency from claim 33. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of dependent claim 41.

**V. Rejection of Claims 125-133 Under 35 U.S.C. § 103(a)**

Claims 125-133 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Westbury in view of Swan and in further view of the Examiner’s Official Notice. (See pg. 14 of the Office Action)

Regarding dependent claims 125 and 126, Applicant traverses this rejection for at least the following reasons. As discussed above, Westbury and Swan, alone or in combination, are deficient vis-à-vis independent claim 33, and the Examiner’s Official Notice does not make up for the deficiencies of Westbury and Swan. Accordingly, Applicant submits that claims 125 and 126 are patentable at least by virtue of their dependency from claim 33. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of dependent claims 125 and 126. Additionally, with regards to claim 125, Applicant seasonably challenges and traverses the Examiner’s assertion that it is well-known in the art to retrieve a network address of a computer system and transmit the network address to another computer system before the date of this invention and requests the Examiner to provide a reference that allegedly discloses this feature of claim 125.

With regards to independent claim 127, Applicant points out that independent claim 127 recites “[a] system ... comprising:” *inter alia* “a carrier computer system ... configured to: receive the object identification data; receive package identification data; receive event data that is generated as the object passes through at least one portal having at least one scanner; *store the object identification data in association with the package identification data and the event data in association with the package identification data; tag the object identification data, the*

*package identification data, and the corresponding event data such that the tagged data can be read and used by computer systems implementing various data formats, protocols, and applications; and transmit the tagged data to a third computer system.”*

Since independent claim 127 contains features that are analogous to, though not necessarily coextensive with the features recited in claim 33, Applicant submits that claim 127 and its dependent claims 128-133 are patentable at least for reasons analogous to those submitted for claim 33. Applicant notes that the Examiner does not appear to take any Official Notice with respect to independent claim 127 although claim 127 is stated as being rejected under Westbury, Swan and Examiner’s Official Notice. (See pg. 14 of the Office Action) Rather, the Examiner merely provides the sweeping and general assertion that “claims 127-133 are directed to a system which recites no new elements as those already presented and rejected” and “[t]hus, these elements are each rejected on a similar basis.” (See pg. 16 of the Office Action) To the extent that the Examiner intended to reject claims 127-133 on the basis of Official Notice, Applicant seasonably challenges and traverses such an assertion and requests the Examiner to disclose a reference that allegedly makes up for the deficiencies of Westbury, Swan and Boucher.

## **VI. New Claims**

Applicant herein adds new claims 134-137 to provide more varied protection of Applicant’s invention as described in the specification. In addition to their respective dependencies from independent claims 33 and 127, Applicant submits that claims 134-137 are independently patentable given that the cited references, alone or in combination, do not teach or suggest the features of these claims.

## **VII. Conclusion**

In view of the foregoing remarks, Applicant respectfully submits that all of the claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. Examiner Zare is encouraged to contact Applicant’s undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

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Reply to Office Action of April 30, 2008

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Cory Davis", with a stylized flourish at the end.

Cory C. Davis  
Registration No. 59,932

**Customer No. 00826**  
**ALSTON & BIRD LLP**  
Bank of America Plaza  
101 South Tryon Street, Suite 4000  
Charlotte, NC 28280-4000  
Tel Atlanta Office (404) 881-7000  
Fax Atlanta Office (404) 881-7777

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